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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,357	06/19/2001	Lothar K. Faber	A7694	9655

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EXAMINER

NGUYEN, THONG Q

ART UNIT PAPER NUMBER

2872

DATE MAILED: 01/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/883,357

Applicant(s)

FABER, LOTHAR K.

Examiner

Thong Q. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 2-6 and 10-19 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7-9 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendment and the Declaration filed on 10/09/2003.

Drawings

2. The drawings were received on 10/09/2003. These drawings are approved by the Examiner.

Specification

3. The substitute specification filed on 10/09/2003 has been received and entered into the present application.
4. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 103

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
6. Claims 1, 7-9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fehr et al in view of Koyama et al (both of record).

See the rejection as set forth in the previous Office action (Paper No. 16, pages 4-6).

Response to Arguments

7. Applicant's arguments filed on 10/09/2003 have been fully considered but they are not persuasive for the following reasons.

First, regarding to the applicant's arguments that the combined art does not disclose all of the features recited in the present claims (see amendment, page 9), the Examiner respectfully disagrees with the applicant's opinion. The applicant is respectfully invited to review the rejection as set forth in the previous Office action which showed that all of the features claimed in the present claims are disclosed in the combined product provided by the teachings of Fehr et al and Koyama et al. In particular, the features relating to the microscope body, the objective housing, the stereo objective, the compound objectives, the means for changeover the types of objectives in an automated fashion are disclosed in the microscope provided by Fehr et al, and the features relating to the bright field illumination and fluorescent illumination are provided by Koyama et al.

Applicant has also argued that the combined product provided by Fehr et al and Koyama et al are deficient by not hinting at the combination of bright field and fluorescent illumination with both compound and stereoscopic objective as recited in present claim. The examiner respectfully disagrees with the applicant's opinions. Applicant should note that the combined product with the structural objectives, provided by Fehr et al, and the illumination types, provided by Koyama et al, will provide one skilled in the art a bright field illumination or a fluorescent illumination based on the selection of the illumination. Either type of

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illumination is used with the selection of a stereoscopic objective or a compound objective.

Second, applicant's arguments relating to the advantages of the inventive device such as enormous savings in time, labor and capital, such an argument are not persuasive. Applicant should note that such arguments do not comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

Third, in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Fourth, in response to the applicant's arguments that there is no reason expectation of success due to the differences in structures of the microscopes provided by Fehr et al and Koyama et al, the Examiner respectfully disagrees with the applicant's opinions. Applicant should note that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those

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of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Fifth, In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both references of Fehr et al and Koyama et al are directed to microscopes having means for changeover different types of optical elements including different objective lens systems for the purpose of providing different types of illuminations and observations. The teaching, i.e., the types of illuminations, provided by Koyama et al is used by the Examiner in the combination to show to one skilled in the art that different types of illumination can be used in a microscope having means for changeover different optical components of a microscope and the types of illuminations are able to select from either a bright field illumination or a fluorescent illumination. Either type of illumination is used with the selection of a stereoscopic objective or a compound objective.

Sixth, in regard to the Declaration filed by the applicant to show the commercial success, filling a long-felt need and the copy of the inventive device by other

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party, it is noted that the Declaration have been fully considered but it is not sufficient to overcome the rejection for the following reasons.

Applicant has argued that the device as claimed has a commercial success and fills a long-felt need; however, a bare statement without any clearly evidence to support for the statement is insufficient and thus is not persuasive. Applicant has failed to provide any written evidence to show the combinations of factors relating to the number of sales, the market share, the product which are actually used by the user/buyer, the time of sale, the advertising, etc...for the purpose of support the statements claimed.

With regard to applicant's arguments concerning the copy of the inventive device by different party as stated in the Declaration, applicant's bare statement that a different party is copied the inventive device as stated is not sufficient because applicant has failed to file written evidence to show that the party has tried for a substantial length of time to design a product similar to the claimed invention, but failed and then copied the claimed invention instead.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

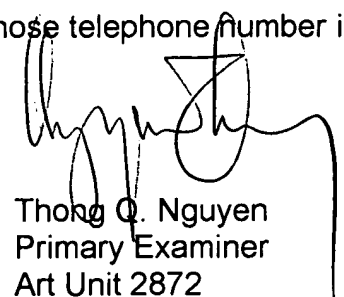
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shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q. Nguyen whose telephone number is (703) 308-4814. **Note that after Jan. 20, 2004, the examiner may be reached at his telephonic number of 571-272-2316.** The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A. Dunn can be reached on (703) 305-0024. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 0956.



Thong Q. Nguyen
Primary Examiner
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